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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,102	09/26/2003	Atsushi Nakajima	KON-1829	1185
20311	7590	12/15/2005	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/673,102

Applicant(s)

NAKAJIMA, ATSUSHI

Examiner

Sanza L. McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 23, 2005 has been entered.

***Response to Amendment***

2. In response to the Amendment received on November 23, 2005, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 1-20 and the addition of claims 21-40.

***Response to Arguments***

3. Applicant's arguments filed November 23, 2005 have been fully considered but they are not persuasive. Applicant's arguments regarding Laskin (6,232,361) are moot, since the rejection was withdrawn in the Advisory action, mailed November 4, 2005. The argument's regarding Takami (5,721,020) are moot since this art was not applied in any rejections. The arguments regarding Sanenobu (JP 2003-212965) and Yasuo (JP 2002-188025) remain since they are deemed to anticipate applicant's instantly claimed invention. Applicant is relying on the limitations "used for an ink jet recording apparatus which has on-demand type ink jet nozzles that employ two or more separate droplets each with a different volume..." and "polymer dispersant" to overcome the above listed prior art references. However the examiner is interpreting the first limitation as a future intended use limitation and that any ink composition comprising those instantly claimed components should be able to be used in the same way since there are no other distinguishing features of said ink components. The polymeric dispersants are taught in the two above listed rejections and are explained in the below rejections.

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4. The disclosure is objected to because of the following informalities: There is not a Brief Description of the drawings section/explanation in the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. Claims 21-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Yasuo et al (JP 2002-188025).

Yasuo et al teaches actinic energy curable ink-jet ink compositions. Said ink composition comprises from 10-50-wt% of an epoxy compound (oxirane), from 50-90-wt% of an oxetane compound, and 0-40-wt% of a vinyl ether compound with a pigment, cationic photoinitiator, and pigment dispersant. Said oxetane compounds are described in [0022] to [0043], wherein these are deemed to anticipate claims 29-33. All component claim ranges are within applicant's ranges and are therefore anticipated. The pigment dispersant, as taught by Yasuo, is a polymeric material described in [0049] to [0053]. Yasuo et al teaches a similar ink-jetting method for said composition in

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paragraph [0055], therefore the methods of claims 39-40. The ink jet composition is deemed to be anticipated by Yasuo, therefore the compositions are deemed to anticipate applicant's claimed invention as written; and thusly, the compositions of Yasuo, in the absence of unexpected results and/or evidence to the contrary, should inherently have the same viscosity properties as claimed by applicant.

8. Claims 21-40 are rejected under 35 U.S.C. 102(a) as being anticipated by Sanenobu (JP 2003-212965).

Sanenobu teaches active energy curable ink compositions. Said composition comprises (A) an epoxy compound, (B) an oxetane compound, (C) a cationic photopolymerization initiator, (D) a pigment and (E) and pigment dispersant. Said pigment dispersant is a comb polymer with basic anchors and liquid at room temperature. This is deemed to anticipate the composition of claim 1. Said oxetane compounds can be found in paragraphs [0012] to [0018], wherein the compounds of claims 29-33 can be found. The pigment dispersant can be found in [0026]. The additive of amounts for all components in the composition can be found in [0009], wherein these are deemed to be within applicant's claimed ranges. Sanenobu teaches these ink can be used in convention ink-jet printers, therefore claims 39-40 are deemed anticipated by the reference. The compositions of Sanenobu is deemed to anticipate applicant's claimed invention as written; and thusly, the compositions of Sanenobu, in the absence of unexpected results and/or evidence to the contrary, should inherently have the same properties as claimed by applicant.

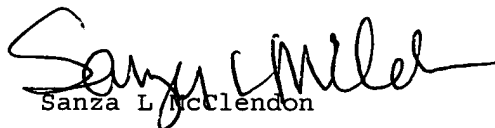
#### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanza L. McClendon

Examiner

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